

REMARKS

Claims 1-38 and 41-57 are pending in this application and all stand rejected under 35 U.S.C. §103. Independent claims 1, 25, 35-38, 41, 49, 55 and 57 have been amended. Claims 39 and 40 are canceled. Reconsideration of this application in light of these amendments and the following remarks is respectfully requested. All pending claims distinguish over the patents applied in the above office action and are allowable for at least the following reasons.

Claim rejections under 35 U.S.C. §103

Even when combined, the references do not teach the claimed subject matter.

Claims 1-4, 6-7, 12, 21-25, 27, 35-38, 41, 49, 55 and 57 are rejected under 35 U.S.C. §103(a) as being unpatentable over Osborn et al (U.S. 6,182,048) (Osborn) in view of Bakoglu et al (U.S. 5,983,369) (Bakoglu), and further in view of Johnson (U.S. 6,904,592) (Johnson). Claims 8, 11, 13-17, 20, 28, 31-34, 42, 45-48, 50, 51 and 54 are rejected under 35 U.S.C. §103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Olarig et al (U.S. 6,032,257) (Olarig), and further in view of Johnson. Claims 5, 9, 10, 26, 29, 30, 43-44, and 52-53 are rejected under 35 U.S.C. §103(a) as being unpatentable over Osborn in view of Bakoglu and further in view of Wallis et al (U.S. Pub. 2001/0051884) (Wallis), and further in view of Johnson. Claims 18-19 and 56 are rejected under 35 U.S.C. §103(a) as being unpatentable over Osborn in view of Bakoglu and further in view of Olarig and further in view of Johnson,.

As shown below, these rejections are not applicable to amended independent claims 1, 25, 35-38, 41, 49, 55 and 57 and their respective dependent claims.

As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with claim 1 for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Osborn, Bakoglu, Johnson, Olarig and Wallis alone, or in any

combination, do not appear to teach or suggest a warranty method or system reciting, among other things, determining warranty price using the configuration, warranty time remaining, reliability of components in the configuration, age of components in the configuration and/or replacement cost of components in the configuration. For example, Osborn discloses pricing vehicle insurance prices using factors such as vehicle make, model and year, mileage of vehicle, as well as geographic factors and environmental factors. See Column 1, lines 51-65. Johnson appears to disclose a method for upgrading software for vehicle fueling sites, not warranties. See Column 4 lines 8-24 and Figures 1-6. Bakoglu is an online computer support system where a representative can control the user's computer remotely. See, for example, Abstract and Figure 1. Wallis appears to provide online warranty services, but not for warranty updates. The updates that Wallis appears to be disclosing are for product repair or status updates. See Paragraph 12. And finally, Olarig relates to computer hardware theft-protection by encoding the hardware. See entire patent.

Therefore, it is impossible to render the subject matter of claims 1, 25, 35-38, 41, 49, 55 and 57 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1, 25, 35-38, 41, 49, 55 and 57 and the rejections under 35 U.S.C. §103(a) are not applicable.

The references are not properly combinable as the references do not teach or suggest the combination.

There is still another compelling, and mutually exclusive, reason why Osborn, Bakoglu, Johnson, Olarig and Wallis cannot be combined and applied to reject claims 1, 25, 35-38, 41, 49, 55 and 57 under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the respective references do not teach, or even suggest, a warranty method or system reciting, among other things, determining warranty price using the configuration, warranty time remaining, reliability of components in the configuration, age of components in the configuration and/or replacement cost of components in the configuration.

Thus, none of these patents provides any incentive or motivation supporting the desirability of the combination as indicated above showing the wide variety of technologies for the cited references. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of claims 1, 25, 35-38, 41, 49, 55 and 57.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1, 25, 35-38, 41, 49, 55 and 57. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1, 25, 35-38, 41, 49, 55 and 57 and the rejections under 35 U.S.C. §103(a) are not applicable.

The references are not properly combinable as the Osborn patent is from a nonanalogous art.

In the present case, the present invention relates to a computer system warranty. To the contrary, Osborn is purports to be limited to **vehicle insurance policies**. See entire patent. 35 U.S.C. §103(a) requires that obviousness be determined on the basis of whether at the time the invention was made a person of ordinary skill in the art to which the subject matter pertains would have found the claimed invention as a whole obvious. Although one of ordinary skill in the art is presumed to be aware of all prior art in the field to which the invention pertains, he or she is not presumed to be aware of prior art outside that field and the field of the problem to be solved, *i.e.*, nonanalogous art. Accordingly, in assessing the propriety of any assertion of prior art as a basis for a *prima facie* case of obviousness, one must determine the scope or bounds of the knowledge of one of ordinary skill in the art, *i.e.*, the analogous art presumably known by one of ordinary skill in the art.

Here, because automobile insurance policies are clearly outside the filed of computer system warranties, Osborn is surely from a nonanalogous art, thus precluding any *prima facie* case of obviousness.

For this reason alone, the USPTO's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of all claims under 35 U.S.C. §103(a) should be withdrawn.

The references are not properly combinable because the recognition of a problem, or of the source of the problem, is not obvious even though the solution to the problem may be obvious.

In the present case, it is apparent from reviewing the Osborn, Bakoglu, Johnson. Olarig and Wallis patents that these do not recognize the problem of computer system warranty upgrades. As discussed above, the references cited do not appear to relate to computer system warranty upgrades as recited by the amended claims. Thus, this is a classic example of a solution to a problem being obvious only after recognition of the problem by the applicant and is part of the "subject matter as a whole" language of 35 U.S.C. §103(a), which should always be considered in determining the obviousness of an invention under this statute.

Thus, for this reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103(a) should be withdrawn.

The dependent claims depend from, and further limit, independent claims 1, 25, 35-38, 41, 49, 55 and 57 in a patentable sense and are therefore allowable as depending from allowable claims.

In view of all of the above, the allowance of claims 1-38 and 41-57 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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